

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TORU YOSHIE and TAKUYA SATOU

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Appeal No. 2001-0267  
Application No. 08/980,352

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HEARD: MARCH 21, 2001

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Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 8, all of the claims in the application. Since claim 4 was canceled subsequent to the final rejection (Paper No. 8), only claims 1 through 3 and 5 through 8 are before us for review.

Appellants' invention pertains to a clipping device. A basic understanding of the invention can be derived from a

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reading of exemplary claim 1, a copy of which appears in the  
APPENDIX to the main brief (Paper No. 13).

As evidence of obviousness, the examiner has applied the  
documents listed below:

Rider	3,780,416	Dec. 25, 1973
Hooven	5,518,164	May 21, 1996

The following rejection is before us for review.

Claims 1 through 3 and 5 through 8 stand rejected under  
35 U.S.C. § 103 as being unpatentable over Rider in view of  
Hooven.

The full text of the examiner's rejection and response to  
the argument presented by appellants appears in the answer  
(Paper No. 14), while the complete statement of appellants'  
argument can be found in the main and reply briefs (Paper Nos.  
13 and 16).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,<sup>1</sup> the applied teachings,<sup>2</sup> and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

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<sup>1</sup> The amendment after final rejection (Paper No. 8) was entered by the examiner (Paper No. 9), but the content thereof has not been clerically entered. While the examiner has indicated that the claims in the brief are correct (page 3 of the answer), this is not the case. Claim 5 in the brief does not show dependency from claim 6 and recite "said link means", consistent with the above-noted entered amendment after final rejection.

<sup>2</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

We cannot sustain the rejection of claims 1 through 3 and 5 through 8 for the reasons set forth, infra.

As disclosed (specification, page 3), an automatic clipping device is provided for holding and bending a clip by the use of a pair of clamps for fastening sheets together with the clip. The device is capable of stopping a bending operation by the pair of clamps if a clip is not between the clamps when an operation of feeding the clip between the clamps is performed a predetermined number of times. Clip-setting-detecting means are provided for detecting whether a separated clip is held by the clamps or not. A control means has a detecting step in which a slider that feeds plate-shaped clips from a cartridge to the clamps is caused to perform an operation of feeding a belt of plate-shaped clips a predetermined number of times, and if the belt of plate-shaped clips is not detected by the clip-setting-detecting means during the predetermined number of times, the clamps and the slider are stopped from being driven. The reference to a predetermined number of times denotes at least two times (Fig. 1; specification, page 23,

line 21 to page 24, line 1). Considering Figure 1 and pages 23 and 24 of the specification, as further explained by appellants (specification, page 10), a sensor detects the existence of a clip in such a way that the light emitted from a light emitting diode is reflected by a film of the clip-arranged belt located on a carrying path of a cartridge and then reflected light is received by a light receiving diode for detecting whether the clip exists or not. Appellants additionally point out that since the detection is performed based on the reflected light from the film, a detection result is strictly accurate, since if the detection is performed based on the reflected light from a clip, the clip cannot be detected when the sensor is situated in a gap between clips.

Claim 1, the sole independent claim, is drawn to a clipping device comprising, inter alia, a cartridge containing a belt of plate-shaped clips, a pair of clamps, a slider, control means, and clip-setting-detecting means, and

wherein said control means has a detecting step in which said slider is caused to perform an operation of feeding the belt of plate-shaped clips per a clip a

predetermined number of times in a state in which said pair of clamps are opened and are ready to receive the belt of plate-shaped clips when no clip is set between said pair of clamps and, if the belt of plate-shaped clips is not detected by said clip-setting-detecting means during the predetermined number of times, said pair of clamps and said slider are stopped from being driven.<sup>3</sup>

The patent to Rider teaches a hand-operated tool for applying clips stored on a carrier strip. As acknowledged by the examiner (Paper No. 5), Rider does not disclose a photodetector to detect the presence of clips at points of the device and does not teach a control system that will stop the operation in response to signals from the photodetector. To overcome this deficiency and provide a suggestion for the modification of the Rider teaching, the examiner relies upon the Hooven patent.

The Hooven disclosure addresses an endoscopic surgical system including an endoscopic stapling and cutting instrument

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<sup>3</sup> As previously mentioned, consistent with the underlying disclosure, we understand the recitation of a predetermined number of times to denote more than one time.

(Fig. 8) having a removable staple cartridge and a sensing means for automatically sensing physical properties of the tissue on which a procedure is being conducted and/or certain parameters of an endoscopic surgical instrument (column 1, lines 15 through 19). As further explained by the patentee (column 6, lines 46 through 53; column 7, lines 33 through 36; and column 8, lines 39 through 42), if desired, the presence of a cartridge and the presence of staples in that cartridge may also be sensed (Figs 14 and 19).

Like the examiner, we conclude that the combined teachings of the applied referenced would have suggested the addition of sensors in the hand operated tool of Rider to gain the advantage of informing a user thereof of the presence of a clip carrier strip and/or clips, following the explicit teaching of Hooven.

However, the above modification would not yield the now claimed invention. As claimed, a control means performs a detecting step in which a slider performs an operation of feeding a belt of plate-shaped clips a predetermined number of

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times, i.e., more than one time, when no clip is set between a pair of clamps, and if the belt is not detected during the predetermined number of times, the clamps and the slider are stopped from being driven. It follows that we, like appellants (reply brief, page 3) do not share the examiner's point of view (answer, page 5) that the claim language specifying a "predetermined number of times" corresponds to "one (1)" time. Since the only evidence before us would not have been suggestive of a "predetermined number of times", the rejection of appellants' claims is not sound.

In summary, this panel of the board has not sustained the rejection of the claims on appeal.

The decision of the examiner is reversed.

REVERSED



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IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
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Administrative Patent Judge	)	APPEALS AND
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